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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,918	07/22/2003	Hoo-min Toong	023.P017	7115
43831	7590	04/26/2010		
BERKELEY LAW & TECHNOLOGY GROUP, LLP			EXAMINER	
17933 NW Evergreen Parkway, Suite 250			WASSUM, LUKE S	
BEAVERTON, OR 97006			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/624,918	Applicant(s) TOONG ET AL.
Examiner Luke S. Wassum	Art Unit 2167

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 April 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-40.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Luke S. Wassum/
Primary Examiner
Art Unit 2167

Continuation of 11. does NOT place the application in condition for allowance because:

Regarding the Applicants' argument that the Rivette et al. reference fails to disclose performing the method of claim 1 without any human intervention, the examiner respectfully disagrees.

The Applicants cite the disclosure in the Rivette et al. reference that the patent citation module collects data for a multi-level patent citation report by repetitively performing the steps of flowchart 8602 (col. 89, lines 15-17), and the fact that the second step of the flowchart 8602 [8606] recites "Receive BOM Names From User", as evidence that the reference fails to disclose a method that takes place without any human intervention.

The examiner points out that immediately following the cited passage (at col. 89, lines 18-20), the Rivette et al. reference discloses that "The level of the report desired by the operator could be contained in the information that the patent citation module receives in step 8606". This disclosure provides ample evidence that the disclosed recursive citation report takes place "without any human intervention", because were the Applicants' interpretation to be correct (that the user manually enters data at each iteration of the report generation), then there would be no need, nor would it make any sense, to submit the level of the report desired by the operator ahead of time, since each additional level would require the user to manually enter the BOM names for that additional level. At each iteration, the user would be required to manually initiate the generation of an additional level of data elements. The only reason why an operator might enter a desired depth at the initiation of the report generation process would be if the system generated the report to the specified depth without any input on the part of the user.

Given the disclosure, it is clear that the system disclosed by the Rivette et al. reference allows a user to submit a seed document(s) [BOM name], along with a desired recursion depth, and in response, the system generates a patent citation report to the operator specified depth without any human intervention.

Regarding the Applicants' argument that Rivette does not speak to generating a different query based at least in part on the results of a prior query, the examiner respectfully disagrees.

As discussed above, the Rivette et al. reference performs recursive patent citation report generation by recursively executing the process illustrated in flowchart 8602 in Drawing Figure 86. Therein, in step 8610, the database is queried to identify those patent documents which are cited by the user submitted seed document(s). An ordinary artisan would certainly understand that in order to carry out this operation, the use of cited patents identified in step 8610 (the claimed data elements of the first set) would be required in order to generate the query for the next iteration of the process. There is no other possibly mechanism for identifying subsequent generations of cited/citing patent documents than by using the output of one iteration of the process as input to the queries executed as part of the subsequent iteration of the patent citation report generation process.

Regarding the Applicants' argument that the Office's interpretation of the term "data elements" is incorrect, the examiner respectfully disagrees.

In spite of any disclosure in the Applicants' specification which indicates a broader interpretation of the term, the Applicants' disclosures at paragraphs [0014] through [0019] make clear that the Rivette et al. reference reads on the claims.

For instance, paragraph [0014] reads:

A method of searching a database to identify prior art publications for a starting patent publication is described herein. In one embodiment, the method can include identifying a first set of publications that are cited by a starting patent publication, identifying a second set of publications that cite the publications of the first set, and generating data based on the publications of the first and second sets and the citation relationships between the publications.

There is nothing in the Applicants' claims which require an interpretation any different than that disclosed by this embodiment. The Rivette et al. reference reads squarely on the Applicants' claimed invention.

The rejections of record are maintained.